

REMARKS

Claims 1-3, 10-15, and 22-23 are pending in the present application. In the Office Action, claims 1-2, 10-11, 13-14, and 22 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Recktenwald, et al (U.S. Patent No. 6,439,345) in view of Berson (U.S. Patent No. 6,802,005). Claims 3 and 15 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Recktenwald and Berson and further in view of Stephens, et al (U.S. Patent No. 6,323,782). Claims 12 and 23 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Recktenwald and Berson and further in view of Keagy, et al (U.S. Patent No. 6,069,969). The Examiner's rejections are respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. That is, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Third, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found

in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. A recent Federal Circuit case emphasizes that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

Recktenwald describes an item pick-up system 100 that permits a customer, or other non-employee person acting for the customer, such as a relative or friend, to pick up a purchased item when the item is not available on the sales floor or when the person must, or wishes to, pick up the item at a later time. See Recktenwald, col. 4, ll. 47-53 and Figure 1. The customer, or the customer's representative, may use a barcode scanner 200 of a kiosk 104 to scan a barcode from a sales check that was presented to the customer by a point-of-sale register attendant at the time that the customer purchased the item. See Recktenwald, col. 6, ll. 58-63. The item pick up system 100 then searches one or more databases to find the items associated with the scanned barcode from the sales check.

However, as admitted by the Examiner, Recktenwald does not describe or suggest the use of a two-dimensional barcode, as set forth in independent claims 1 and 13 of the present invention. Moreover, as also admitted by the Examiner, Recktenwald does not describe or suggest scanning and decoding the two-dimensional barcode to obtain the user's previously provided biometric information, conveying the user's current biometric information to the retrieval device, and, if the user's current biometric information is equivalent to the user's

previously provided biometric information, providing the package to the user, as set forth in independent claims 1 and 13 of the present invention.

To remedy at least the acknowledged deficiencies of the primary reference, the Examiner cites Berson, Keagy, and Stephens. Berson describes techniques for generating a card that includes a two-dimensional bar code, which represents encrypted biometric information associated with an employee. See Berson, col. 3, line 18 – col. 4, line 25. The card may be used to track the time the employee spends at a job site. Keagy describes using a two-dimensional barcode to encode information extracted from a fingerprint to verify the identity of a user. Stephens describes transmitting information regarding item delivery via a radiofrequency transmission or a cell phone.

However, Applicant respectfully submits that the cited references provided no suggestion or motivation to combine the teachings of the primary reference with the teachings of one or more of the secondary references to arrive at Applicant's claimed invention. In particular, Applicant submit that neither Recktenwald nor Berson provide any suggestion or motivation to combine the card including the two-dimensional bar code described by Berson and the package retrieval system described by Recktenwald. To the contrary, Recktenwald appears to teach away from the Examiner's proposed modifications.

The item pick up system described by Recktenwald permits a customer, or other non-employee person acting for the customer, such as a relative or friend, to pick up a purchased item. Thus, Applicant respectfully submits that Recktenwald appears to teach away from any method that associates a particular person with the sales check. For example, Recktenwald teaches away from imprinting the sales check with a two-dimensional bar code that represents biometric information associated with the person who purchased the item because this would not

allow other non-employee persons acting for the customer, such as a relative or friend, to pick up the purchased item. Thus, Recktenwald teaches away from scanning and decoding the two-dimensional barcode to obtain the user's previously provided biometric information, conveying the user's current biometric information to the retrieval device, and, if the user's current biometric information is equivalent to the user's previously provided biometric information, providing the package to the user, as set forth in independent claims 1 and 13 of the present invention. It is by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious. *See, inter alia, In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Nielson*, 2 U.S.P.Q.2d (BNA) 1525, 1528 (Fed. Cir. 1987); *In re Hedges*, 228 U.S.P.Q. (BNA) 685, 687 (Fed. Cir. 1986).

In response to this argument, the Examiner states that Recktenwald does not require that a person other than the customer pick up a purchased item. The Examiner therefore alleges that Recktenwald does not teach away from the Examiner's proposed modification because the customer could pick up the purchased item. Applicant respectfully disagrees and notes that whether or not the customer may pick up the purchased item is not relevant to determining whether or not Recktenwald teaches away from the present invention. As discussed above, and as admitted by the Examiner at item 11 on page 4 of the Final Office Action, Recktenwald teaches that it is a possibility that someone other than the customer may pick up the purchased item. Applicant submits that the possibility that someone other than the customer may pick up the purchased item implies that biometric information associated with the customer should not be used to identify the person picking up the purchased item. Consequently, as also admitted by the Examiner, Recktenwald teaches that a customer identification number (*i.e.*, information that may

be passed from the customer to an authorized person, unlike biometric information) may be used to verify the person picking up the purchased item.

For at least the aforementioned reasons, Applicant respectfully submits that the Examiner has failed to make a *prima facie* case that the present invention is obvious in view of the prior art of record. Applicant requests that the Examiner's rejections of claims 1-3, 10-15, and 22-23 under 35 U.S.C. 103(a) be withdrawn.

For the aforementioned reasons, it is respectfully submitted that all claims pending in the present application are in condition for allowance. The Examiner is invited to contact the undersigned at (713) 934-4052 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

Date: _____

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